APPENDIX

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

No. 9399

GUSTAV H. BOBERTZ, JR., *Plaintiff*,

v.

GENERAL MOTORS CORPORATION, *Defendant*.

Order Granting Defendant's Motion for Summary Judgment

Plaintiff sues for infringement of Patent No. 1,911,600 relating to improvement in automobile hoods. Defendant denies infringement and attacks validity of the patent for lack of novelty and patentable invention. Issue was joined, pre-trial hearing had and a pre-trial order entered defining the issues, following which exhaustive discovery proceedings ensued by both parties.

Defendant filed motion for summary judgment under Rule 56, claiming absence of any genuine issue of material fact. Oral argument was had and all exhibits were made available to the court, including defendant's accused device. Briefs were filed fully covering the issues involved.

Ordinarily, courts are reluctant to decide important issues by summary judgment because of the lack of a record adequate to explain the issues of fact and law. Parke, Davis & Co. v. American Cyanamid Co. et al., (6 Cir.), 207 F. 2d 571, citing Estepp v. Norfolk & W. Ry. Co., (6 Cir.), 192 F. 2d 889. In the latter, a personal injury case, and in Begnaud et al v. White, (6 Cir.), 170 F. 2d 323, a contract case, the court ruled that where a genuine issue of material fact exists summary judgment should not be granted, but in the Parke, Davis & Co. v. American Cyanamid Co. et al. case, supra, a patent case, the court said, p. 573, "but here the issues are clarified by extensive interrogatories filed by both parties and answered fully".

Both parties in this case resorted to extensive discovery proceedings, filing of affidavits and exhibits, and making admissions. The court also had the benefit of the Patent Office file wrapper showing the history of the prosecution of this patent. The thoroughness of the pre-trial activities of both parties resulted in the elimination of any genuine issue of material fact in dispute. Under such circumstances it has been held that where no factual issues are present and where the patents and products involved are sufficiently simple to make expert testimony unnecessary, disposition under Rule 56 is proper. Bridgeport Brass Co. v. Bostwick Laboratories, (2 Cir.), 181 F. 2d 315, 316, 319; Steigleder v. Eberhard Faber Pencil Co. et al., (1 Cir.), 176 F. 2d 604, certiorari denied, 338 U.S. 893; Vulcan Corp. v. International Shoe Machine Corp., D.C.D. Mass., 68 F. Supp. 990, affirmed 1 Cir., 158 F. 2d 520, certiorari denied, 330 U.S. 825, 67 S. Ct. 868, 91 L. Ed. 1275; Alex Lee Wallau, Inc. v. J. W. Landenberger & Co., 121 F. Supp. 555, 556. Defendant's accused hood is a partially transparent counterpart of the regular steel hood used in all of defendant's 1949 Oldsmobile "Rocket Engine" automobiles. Both hoods were available to the court for examination and comparison with plaintiff's hood of the claimed invention, which in Figure 2 of the patent drawings follows closely the automobile hood structure of defendant's 1932 Chevrolet automobile.

In Steigleder v. Eberhard Faber Pencil Co. et al. case, supra, the court in approving disposition of certain patent cases under Rule 56 said: "Where it is apparent that there is no genuine issue of fact bearing on infringement, and the structure and mode of operation of the accused device are such that they may be readily comprehended by the court, and compared with the invention described and claimed in the patent, without the need of technical explanation by the testimony of expert witnesses, then the court, if satisfied that there is no infringement, should give summary judgment for the defendant, instead of

subjecting the parties to the expense of a trial." To the same effect Smith v. General Foundry Mach. Co., (4 Cir), 174 F. 2d 147, certiorari denied, 338 U.S. 869.

The five combination claims of the patent in suit are directed to an automobile hood made of transparent material, consisting of two vertical members, and either one or two horizontal members with a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of said members to form a unitary structure therefrom, and securing means adapted to coact with a hold-down latch on the vehicle body to removably secure the hood to the vehicle body. The specifications state the object of the patent to be an invention to provide an automobile hood formed of transparent material, which permits full visibility of an engine of a motor vehicle at all times. Claim 1 is representative.[1] This transparent automobile hood would only temporarily replace the ordinary hood and was not intended for regular use in an automobile. The novelty of this invention is stated in the specifications to reside in the transparency of the top and sides of the automobile hood, for display or study purposes, enabling the observer full visibility of the engine.

The specifications also state that the automobile hood of the invention may be formed of a single sheet of transparent material, or a plurality of independent sheets of such material, and while it is also stated in the specifications that the applicants for the patent do not desire to be limited to any type of hood fastening means, nor to a particular shape or configuration of such a hood, but desire to avail themselves of all changes in the scope of

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[1] An automobile hood including two transparent vertical members, two substantially horizontal transparent members, a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of said members to form a unitary structure therefrom, and securing means adapted to coact with a hold-down latch on the vehicle body to removably secure the said hood to the vehicle body.

the appended claims, it is clear upon examination of the file wrapper history of the prosecution of this patent, and the language of the claims of the patent, that the claims finally granted are expressly limited to an automobile hood of several pieces made of any transparent material and joined together by transparent reinforcing means to form a unitary structure.

The original application filed in the Patent Office had seven claims, all rejected by the Patent Office. A total of nine new claims were filed during subsequent proceedings in the Patent Office, of which five were finally allowed. These rejected claims included language relating to "transparent means for enclosing the portion of the vehicle between the radiator and the cowl"; a "transparent automobile hood formed of transparent material"; and later, "of sheet celluloid". The rejected claims presented nothing patentable over Rumpler (German) #379,379 (1923) which, in claims 1 and 4, describe a motor vehicle hood constructed from transparent celluloid. No invention is claimed on the latching means, and the substitution of the temporary hood in place of the conventional hood in an automobile is taught by Martin #1,382,959 (1921).

As pointed out by the Patent Office, the combination of a cowl, radiator shell, a hood, and the latching means for the hood, is an old one, as disclosed in Martin. No invention would be involved in substituting sheet celluloid for the wire mesh covering in Martin, in view of the transparent hood shown in Rumpler, the moulded celluloid used in Rumpler being equivalent to sheet celluloid, and the use, broadly, of transparent reinforcing means is not a patentable distinction, since an ordinary prudent mechanic would naturally locate the reinforcing means to conform with the design of the vehicle body. The reinforcing rods in Martin are adapted to conform with the design of the vehicle body, as stated by the Patent Office, and afford no basis for a patentable invention.

The patent was finally allowed only when the claims were presented in the specific language suggested by the Examiner, limiting the grant to the vertical and horizontal transparent members and reinforcing means disposed to conform the body design of the motor vehicle upon which the hood is placed, with latching means on the vehicle body.

The claims of the patent do not disclose the nature of the transparent material of which the hood is made, and although it is stated in the specifications that the hood of the invention may be formed by a single sheet of transparent material or a plurality of independent sheets of such material, the Patent Office repeatedly and finally rejected claims for a one-piece transparent hood, in view of Rumpler whose patent disclosed an automobile hood of transparent celluloid.

In 1949 defendant caused to be made and distributed to its Oldsmobile dealers a quantity of "plexiglas" transparent automobile hoods made of sheet plastic material, to be used in displaying and demonstrating its Oldsmobile "Rocket Engine" and other parts of an automobile usually located under the hood, without the necessity of raising the hood for each individual display or demonstration. This hood was made of a single sheet of material variously referred to as plexiglas, celluloid, and plastic. The transparent portion in the center of the hood covers about two-thirds of its surface.

The claims of plaintiff's patent are specific and limited to a transparent hood consisting of separate vertical and horizontal parts joined together by reinforcing means, in order to form a unitary structure. Defendant's accused hood is made in one piece, with six ordinary screw-fastenings openings for attachment to the body and chassis of the car, without separate vertical members and without any reinforcing means connecting together the several pieces of transparent material comprising the structure of the patent.

During the prosecution of his application in the Patent Office plaintiff cancelled claims sufficiently broad in scope to cover the one-piece hood which was made of a single sheet of transparent plastic and took the claims of the patent which are specific to the plural-piece hood as illustrated in Figures 1 and 2 of the patent, with the reinforcing ribs connecting the individual members. By cancelling his original claims plaintiff created an express limitation relating to the inventive step, and cannot now be permitted to depart from the plain meaning of the language he adopted or to claim from such language a broad and generic construction. A. O. Smith Corporation v. Lincoln Electric Co., (6 Cir.), 82 F. 2d 226, 229. In determining the scope of a patent, intent and inventor's own appraisal of the nature of the invention are important; that which is not literally within a claim does not infringe. Directoplate Corp. v. Donaldson Lithographing Co., (6 Cir.), 51 F. 2d 199, 202. Having finally drawn his claims narrowly to avoid the prior art and obtain allowance of the claims, plaintiff cannot now attribute a broader construction to the words of his claims. Falkenberg v. Golding et al., (7 Cir.), 195 F. 2d 482. Plaintiff's claims must be read in the light of the invention disclosed and cannot be given a construction broader than the teachings of his patent as shown by the claims allowed. Ford Motor Co. v. Gordon Form Lathe Co., (6 Cir.), 87 F. 2d 390, 392; Blanc v. Curtis, (6 Cir.), 119 F. 2d 395, 397.

In Midland Steel Products v. Clark Equipment Co., (6 Cir.), 174 F. 2d 541, 545, the court quotes from D'Arcy Spring Co. v. Marshall Ventilated Mattress Co., (6 Cir.), 259 F. 236, 240, 241, "* * * where the claim defines an element in terms of its form, material, location or function, thereby apparently creating an express limitation, where that limitation pertains to the inventive step rather than to its mere environment, and where it imports a substantial function which the patentee considered of importance to his invention, the court cannot be permitted to say that

other forms, which the inventor thus declared not equivalent to what he claimed as his invention, are nevertheless to be treated as equivalent, even though the court may conclude that his actual invention was of a scope which would have permitted the broader equivalency.", citing R. M. Hollingshead Co. v. Bassick Mfg. Co., (6 Cir.), 73 F. 2d 543, 548; Firestone Tire & Rubber Co. v. United States Rubber Co., (6 Cir.), 79 F. 2d 948, 955; United Shoe Machinery Corp. v. O'Donnell Rubber Products Co., (6 Cir.), 84 F. 2d 383, 386; Shearer v. Atlas Radio Co., (6 Cir), 94 F. 2d 304, 306; A. O. Smith Corporation v. Lincoln Electric Co., (6 Cir.), 82 F. 2d 226, 229." See also Whitman et al. v. Andrus, (6 Cir.), 194 F. 2d 270.

When claims are rejected and withdrawn while invention is pending in the Patent Office the patentee is estopped to contend that the allowed claims should be given the same breadth and interpretation as the abandoned claims. Baker-Cammack Hosiery Mills v. Davis Co., (4 Cir.), 181 F. 2d 550, 563; Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126, 136. In the case of Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 220 the court said: "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent." And, in Smith v. Magic City Kennel Club, Inc., 282 U.S. 784 790 the Supreme Court stated the rule as follows: "The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. Sargent v. Hall Safe & Lock Co., 114 U.S. 63, 86; Shepard v. Carrigan,

supra, 598; Hubbell v. United States, supra, 85. The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. Morgan Envelope Co. v. Albany Paper Co., 152 U.S. 425, 429."

Besides the Rumpler patent, there are others in the art prior to Bobertz who taught the use of transparent hoods on automobiles, such as the French publication La Locomotion, issued February 11, 1911, and filed in the United States Patent Office January 6, 1931, showing a transparent glass hood on an automobile, and The Motor, a publication of London, England, dated July 2, 1912, showing a Cadillac automobile with a transparent glass hood. Also, in the Kelsey patent, No. 1,045,152, (1912) there is disclosure of a removable transparent dome of an airplane covering the hatchway, and a series of concave and convex transparent sections conforming to the curvature of the housing set in the bottom and sides of the housing to permit inspection of the exterior mechanisms and surface below.

A transparent automobile hood was old in the art. Whether it be made of glass, plexiglas, celluloid or plastic, its function prior to the patent here was identical with its function in this patent. The several pieces of transparent material constituting plaintiff's inventive effort function in the same manner and serve the same purpose as the prior art patents and publications without regard as to the type of transparent material described. The Bobertz patent here does not come up to the high standard of patentable invention required to sustain combination claims such as the claims in this suit. Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147; Cuno Engineering Corp. v. Automatic Devices Corp. 314 U.S. 84.

The claims in suit are not limited to transparent plastic and this limitation cannot be read into the claims in

order to save them from invalidity; Patrol Valve Co. v. Robertshaw-Holton Controls Co., (C.A. 6), 210 F. 2d 146; Aluminum Company of America v. Thompson Products, Inc., (C.A. 6), 122 F. 2d 796; Parke, Davis & Co. v. American Cyanamid Co. et al., supra, in which the court stated (p. 574):

> "The appellant therefore is estopped to deny the limiting effect of the language in the claims because these limitations are adopted to avoid the earlier grounds of rejection and refusal and to obtain allowance of the patent." Citing Shepard v. Carrigan, 116 U.S. 593, 598; I. T. S. Rubber Co. v. Essex Rubber Co., 272 U.S. 429, 433-434; Smith v. Magic City Kennel Club, Inc., 282 U.S. 784, 790, and " * * * An applicant cannot qualify the effect of his acquiescence in the rejection of a claim by stating to the Patent Office that it is not an acquiescence and that he expects to insist upon his right to cover the same ground which the rejected claim covered under other and amended claims. As declared by this court through Chief Justice Taft, then Presiding Judge, in Thomas v. Rocker Spring Co., 6 Cir., 77 F. 420, 431-432, an applicant 'cannot thus destroy the effect of a patent-office ruling.'"

As in the Smith v. Magic City Kennel Club, Inc. case, supra, plaintiff here, resorts to the doctrine of equivalents, claiming that defendant's accused structure contains horizontal and vertical members. Though this be a far fetched argument, by comparing plaintiff's structure with the accused hood, there is in any event an absence of "a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of said members to form a unitary structure therefrom". In the Smith v. Magic City Kennel Club, Inc. case, supra, the court further points out, p. 790, "The petitioner resorts to the doctrine of equivalents, insisting that the rigid horizontal arm of the respondents is to be treated as the equivalent of the arm of the patent, and that the limiting specifications of the claims may be ignored. What has already been said disposes of

this contention, for where a patentee has narrowed his claim, in order to escape rejection, he may not 'by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to disclaimer.' Weber Electric Co. v. Freeman Electric Co., 256 U.S. 668, 677, 678; I. T. S. Rubber Co. v. Essex Rubber Co., supra. It should also be observed that the difference here was both in structure and in mode of operation and result."

Bobertz obtained no new and unexpected results which would rise to the dignity of patentable invention, since the substitution of one material with known characteristics for another material is not invention.

In Electro Mfg. Co. v. Yellin, the court said, 132 F. 2d 979, 981,

> "Plastic products have been made for many years. They are lighter in weight than metal, are translucent, and permit greater variation in color. Nemeroff did not disclose a new material, he merely substituted a plastic material for a material which was used in the prior art, and the District Court held that this did not amount to invention. See Hotchkiss v. Greenwood, 11 How. 248, 52 U.S. 248; Evr-Klean Seat Pad Co. v. Firestone Tire & Rubber Co., 8 Cir., 118 F. 2d 600. * * * we do say that there was no patentable genius involved in Nemeroff's disclosures. This was the District Court's conclusion, and we think it was correct."

See also James Heddon's Sons v. American Fork & Hoe Co., (C.A. 6), 148 F. 2d 230, 232; Seiberling Rubber Co. v. I. T. S. Co., (C.A. 6), 134 F. 2d 71; Goodwin v. Borg-Warner Corp., (C.A. 6), 157 F. 2d 267; Timken-Detroit Axle Co. v. Cleveland Steel Products Corp., (C.A. 6), 148 F. 2d 267, 271.

The claims in suit are limited to reinforcing means shown as strips 9. The mere strengthening or reinforcement of Rumpler's plastic hood would not amount to pat-

entable invention. Associated Plastic Companies, Inc. v. Gits Molding Corp., (C.A. 7), 182 F. 2d 1000, 1005.

Defendant's accused automobile hood does not infringe plaintiff's patent. The patent itself is invalid for want of patentable invention and lack of novelty. Defendant's motion for summary judgment is granted.

ARTHUR A. KOSCINSKI
Arthur A. Koscinski,
District Judge

Dated: August 20, 1954

U. S. District Court
Eastern District of Mich. ss

I hereby certify that the foregoing is a true copy of the original on file in this court and cause.

FRANK J. DINGELL,
Clerk

By (Sgd.) JOSEPHINE M. BOWMAN
Deputy Clerk

Dated: Aug. 20, 1954

No. 12379

UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

GUSTAV H. BOBERTZ, JR., *Appellant*, v. GENERAL MOTORS CORPORATION, *Appellee*.	APPEAL from the United States District Court for the Eastern District of Michigan.

Decided December 14, 1955.

Before MARTIN, MILLER and STEWART, Circuit Judges.

MARTIN, Circuit Judge. The contest here is between Gustav H. Bobertz, Jr., owner of United States Letters Patent No. 1,911,600, covering a transparent automobile hood, and the General Motors Corporation as an alleged infringer of the patent. Plastic Unlimited, Inc., a sales corporation and not a manufacturer, was originally a party to the suit. The suit against that corporation was dismissed on motion, for the reason that the instant litigation was not begun prior to the dissolution of the corporation under the Michigan General Corporation Act, section 450.75. The complaint of Bobertz was served only about two weeks before the expiration of the patent on May 30, 1950. The patent had been issued on May 30, 1933.

Upon denial by General Motors Corporation that the patent was either valid or infringed, issue was joined and a pre-trial hearing had. Extensive discovery proceedings ensued. Pursuant to Civil Procedure Rule 56, General Motors filed a motion for summary judgment insisting that no genuine issue of material fact was pre-

sented; that the patent claims were invalid; and, moreover, that they were not infringed. The prior art was cited and documents filed establishing anticipation of the claimed invention. Several depositions and affidavits were also filed, elaborate briefs were submitted to the court, and oral arguments were presented by both sides. After due deliberation, the district court, in an opinion-order embracing a complete discussion of both the mechanical facts and the applicable law, granted defendants' motion for summary judgment on both grounds and dismissed the suit.

In his deposition, Bobertz asserted that the concept of making a transparent automobile hood came to him though observing a parked Plymouth car which attracted a number of observers because of the fact that its hood was provided with transparent windows for the purpose of making visible the engine underneath the hood. He noticed, however, that people who tried to see the engine through the small openings in the hood gave up in disgust because they could not actually see the engine. His thought was that it would be much simpler if the whole hood were made of transparent celluloid. His first practical application of this thought was to make a transparent hood for a Chevrolet automobile which duplicated in celluloid the 1932 Chevrolet hood, made of sheet steel, consisting of two substantially horizontal members hinged together at their edges along the longitudinal center of the hood. Two vertical side members were hinged to the abutting edges of the horizontal members; and the hood was secured to the chassis by conventional hood fasteners in use by Chevrolet at that time.

The patent in suit displayed a transparent hood in configuration substantially a duplicate of the sheet-metal hood placed on the Chevrolet automobile manufactured by the General Motors Corporation in 1932. Except that the hood is transparent, the claims of the patent in suit substantially describe a 1932 Chevrolet hood. As stated

by the United States District Court, the five combination claims of the patent in suit are directed to an automobile hood made of transparent material, consisting of two vertical members, and either one or two horizontal members with a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of such members to form a unitary structure therefrom, and securing means adapted to coact with a hold-down latch on the vehicle body to secure removably the hood to the body of the vehicle. The specifications state that the object of the patent is to provide an automobile hood of transparent material permitting at all times full visibility of the engine of a motor vehicle. The specifications declare the novelty of the invention to reside in the transparency of the top and sides of the automobile hood, affording full visibility of the engine. The transparent automobile hood was not intended to be used regularly, but only temporarily to replace the ordinary hood.

The District Court quoted Claim One of the patent as representative. Claim Four is also typical, and reads as follows: "An automobile hood including two transparent vertical members, two substantially horizontal transparent members, a plurality of longitudinally extending transparent reinforcing means connecting the adjoining edges of said members to form a unitary structure therefrom, and means secured to said hood and adapted to permit removable attachment of said hood to a motor vehicle body."

The District Court asserted that it is clear from consideration of the file-wrapper history of the prosecution of the patent in suit and from the language of the patent claims that the claims finally granted were expressly limited to an automobile hood of several pieces made of any transparent material and joined together by a transparent reinforcing means to form a unitary structure.

All seven claims of the original application filed in the Patent Office were rejected; and a total of nine new claims were filed during subsequent proceedings in the Patent Office whereof five were finally allowed. The rejected claims embraced such language as "transparent means for enclosing the portion of the vehicle between the radiator and the cowl"; "transparent automobile hood formed of transparent material"; and the words "of sheet celluloid."

The District Court found that the rejected claims presented nothing patentable over Rumpler (German) Patent No. 379,379 (1923) which, in Claims One and Four, describe a motor vehicle hood constructed from transparent celluloid. The comment was made that no invention is claimed for the latching means, and that the substitution of a temporary hood in place of the conventional hood was taught in 1921 by Martin in Letters Patent No. 1,383,959.

As pointed out by the Patent Office, the combination of the cowl, radiator shell, hood and latching means therefor is old as disclosed in Martin, no invention being involved in substituting sheet celluloid for the wire-mesh covering employed in Martin, in the light of the transparent hood shown in Rumpler. The court stated that the moulded celluloid used in Rumpler is equivalent to sheet celluloid and the broad use of transparent reinforcing means is not a patentable distinction for the reason that an ordinarily prudent mechanic would naturally locate the reinforcing means to conform to the design of the body of the vehicle. The reinforcing rods in the Martin patent are adapted to conform to the design of the vehicle body, as stated by the Patent Office, and afford no basis for patentable invention.

The final allowance of the patent claims ensued only when the claims were presented in specific language suggested by the examiner. The claims for a one-piece

transparent hood were rejected by the Patent Office on the prior art of Rumpler, who disclosed in his patent an automobile hood of transparent celluloid. The claims of the patent in suit do not disclose the nature of the material of which the hood is to be made. The claims of the patent seem specific and limited to a transparent hood consisting of separate vertical and horizontal parts, joined together by reinforcing means, in order to form a unitary structure.

The inventors, while pursuing the application in the Patent Office, cancelled claims sufficiently broad in scope to cover a one-piece hood made of a single sheet of transparent plastic and adopted claims specific as to a multiple-piece hood with reinforcing ribs connecting the individual members.

In *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 220, 221, the Supreme Court said: "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. [Citing cases.] The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. [Citing cases.] The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revise cancelled or rejected claims and restore them to their patents are manifest. See *Leggett* v. *Avery*, 101 U. S. 256, 259. True, the rule is most frequently invoked when the original and cancelled claim is broader than that allowed, but the rule and the reason for it are the same if the cancelled or rejected claim be narrower. [Citing cases.]" Cf. *Smith, Administratrix,* v. *Magic City Kennel Club, Incorporated*, 282 U. S. 784, 790.

The opinion of this court in *A. O. Smith Corporation* v. *Lincoln Electric Co.*, 82 F. (2d) 226, 229, 230 (C. A. 6), declared that the inventor had created an express limitation pertaining to the inventive step, and would not be permitted to depart from the plain meaning of the language he adopted, or to claim for such language a broad and general construction. It was asserted that the file wrapper confirmed the conclusion that the inventor had deliberately limited his claim in a specified manner and that the claim, read in the light of the specifications, measures the invention. See also *Falkenberg* v. *Golding*, 195 F. (2d) 482, 485 (C. A. 7); *Midland Steel Products Co.* v. *Clark Equipment Co.*, 174 F. (2d) 541, 545 (C. A. 6); *D'Arcy Spring Co.* v. *Marshall Ventilated Mattress Co.*, 259 Fed. 236, 240, 241 (C. A. 6); *R. M. Hollingshead Co.* v. *Bassick Mfg. Co.*, 73 F. (2d) 543, 548 (C. A. 6); *Firestone Tire & Rubber Co.* v. *United States Rubber Co.*, 79 F. (2d) 948, 955 (C. A. 6); *Directoplate Corporation* v. *Donaldson Lithographing Company*, 51 F. (2d) 199 (C. A. 6); *Baker-Cammack Hosiery Mills* v. *Davis Co.*, 181 F. (2d) 550, 563 (C. A. 4).

The claims of a patent are to be interpreted, not only in the light of the specifications, but also with reference to file-wrapper history. *Whitman* v. *Andrus*, 194 F. (2d) 270, 275 (C. A. 6); *Schriber-Schroth* v. *Cleveland Trust Co.*, *supra*.

In addition to the German patent issued to Rumpler, No. 379,379, there is in the record documentary evidence, which was presented to the trial judge, that the prior art before the Bobertz patent disclosed an automobile hood of such transparent material that the engine could be viewed. In the issue of February 11, 1911, of a French publication, La Locomotion, there was depicted a glass hood for demonstrating the engine of an automobile of that period. The fact that the hood revealed in La Locomotion, was made of glass and not of plastic is im-

material, for the claims of the patent in suit are not limited to plastic, the use of which in automobile hoods had been revealed in Rumpler. In United States Letters Patent No. 1,045,152, issued to Kelsey on November 26, 1912, covering a "flying machine," transparent sections of celluloid or other transparent material were directed to be so placed that the operator could view "both the operation and adjustment of the mechanism below the plane." A journal published in London, England, The Motor, in its issue of July 2, 1912, showed a Cadillac automobile with a transparent glass hood. In another publication, The Autocar, of date September 28, 1914, this sentence appears: "A very striking feature about the car is a glass bonnet that Mr. Bennett has introduced for trial and demonstration work, and one which apparently attracts a great deal of interest to the car. [A Cadillac.]"

The District Court logically reasoned: "A transparent automobile hood was old in the art. Whether it be made of glass, plexiglas, celluloid or plastic, its function prior to the patent here was identical with its function in this patent. The several pieces of transparent material constituting plaintiff's inventive effort function in the same manner and serve the same purpose as the prior art patents and publications, without regard as to the type of transparent material described. The Bobertz patent here does not come up to the high standard of patentable invention required to sustain combination claims such as the claims in this suit. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147; *Cuno Engineering Corporation* v. *Automatic Devices Corp.*, 314 U. S. 84. The claims in suit are not limited to transparent plastic and this limitation cannot be read into the claims in order to save them from invalidity." *Patrol Valve Co.* v. *Robertshaw-Fulton Controls Co.*, 210 F. (2d) 146 (C. A. 6); *Aluminum Company of America* v. *Thompson Products, Inc.*, 122 F. (2d) 796 (C. A. 6); and *Parke-*

Davis & Co. v. *American Cyanamid Co.*, 207 F. (2d) 571 (C. A. 6), were appropriately cited as authority.

Mere substitution of materials, when no new results are accomplished, does not attain the dignity of invention. *Timken-Detroit Axle Co.* v. *Cleveland Steel Products Corporation*, 148 F. (2d) 267, 271 (C. A. 6); *James Heddon's Sons* v. *American Fork and Hoe Co.*, 148 F. (2d) 230 (C. A. 6); *Seiberling Rubber Co.* v. *I. T. S. Co.*, 134 F. (2d) 871 (C. A. 6); *Goodwin* v. *Borg-Warner Corporation*, 157 F. (2d) 267, 274 (C. A. 6); *United States Appliance Corporation* v. *Beauty Shop Supply Co.*, 121 F. (2d) 149, 150 (C. A. 9); *Hinchman* v. *Jim Robbins Co.*, 113 F. Supp. 302, 304 (E. D. Mich.; Levin, J.).

The Court of Appeals for the Seventh Circuit, in *Electro Mfg. Co.* v. *Yellin*, 132 F. (2d) 979, 981 (C. A. 7), said: "Plastic products have been made for many years. They are lighter in weight than metal, are translucent, and permit great variation in color. Nemeroff [inventor of the patent there in suit] did not disclose a new material, he merely substituted a plastic material for the metal which was used in the prior art, and the District Court held that this did not amount to invention. [Citing cases.] Moreover, the use of transparent and translucent ends for lighting fixtures is old. We do not say that the design patents referred to anticipate the patent in suit, yet we do say that there was no patentable genius involved in Nemeroff's disclosures. This was the District Court's conclusion, and we think it was correct."

It seems almost idle to reiterate that quite a high standard of invention is now exacted to sustain combination claims embracing old elements in a patent. This was made plain fourteen years ago in the opinion of the Supreme Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 90-92. Any lingering doubt as to the intention of the Supreme Court to require strict rather than liberal construction of combination claims was certainly dispelled by its opinion in *Great Atlantic*

& Pacific Tea Company v. *Supermarket Equipment Corp.*, 340 U. S. 147, 154, where the majority opinion concluded that the standard of invention used in the lower courts was less exacting than that required where a combination was made up entirely of old components.

In *General Motors Corp.* v. *Estate Stove Co.*, 203 F. (2d) 912, 917, 918 (C. A. 6), Judge McAllister thus expressed the view of this court: "In an able and ingenious argument, appellee submits that, in specifying a new statutory standard of invention, the Act does not treat combination patents on a different basis from other patents, as it is claimed the Supreme Court did treat them in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162; that the new Section 103 defines a single standard of invention for all patents; that the subject matter as a whole would not have been obvious at the time the invention was made; and that the extent to which the *Great Atlantic & Pacific Tea Co.* case required a different, or more exacting standard, or a more severe test for combination claims than the single standard of invention for all patents, was rejected by Congress in the new Act. We are, however of the view that the priniciple stated in the *Great Atlantic & Pacific Tea Co.* case is not modified by the new Act, but continues to be the law, and is here controlling."

The Court of Appeals for the Seventh Circuit, in *Associated Plastics Companies* v. *Gits Molding Corporation*, 182 F. (2d) 1000, 1005 (C. A. 7), has well said: "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display invention, more ingenuity than the work of a mechanic skilled in the art. Under this test, some substantial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee. The primary purpose of our patent system is not reward of the individual but the advancement of the arts and

sciences. Its inducement is directed to disclosure of advances in knowledge which will be beneficial to society; it is not a certificate of merit, but an incentive to disclosure."

The claimed invention of Bobertz merely duplicated in transparent plastic the conventional Chevrolet hood which was in use in 1932. Bobertz's idea stemmed from his observation of a Plymouth hood having transparent windows for the observation of the engine underneath the hood. The transparent hood designed by Bobertz emanated from an obvious step which might reasonably have occurred to a mechanic skilled in the art.

The appellant patent owner insists that the District Court erred in sustaining the motion of appellee for summary judgment on the ground that the patent is invalid for lack of invention in view of the prior art. The insistence is that there were material issues of fact to be tried, that the court disregarded the presumption of validity from the issuance of the patent by the United States Patent Office and upon subsidiary grounds: all challenging the right of a United States District Court by summary judgment to hold the claims of the patent invalid for want of patentable invention and lack of novelty. The District Judge thus met this argument: "Defendant filed motion for summary judgment under Rule 56, claiming absence of any genuine issue of material fact. Oral argument was had and all exhibits were made available to the court, including defendant's accused device. Briefs were filed fully covering the issues involved. Ordinarily courts are reluctant to decide important issues by summary judgment because of the lack of a record adequate to explain the issues of fact and law. [Citing cases.] . . . Both parties in this case resorted to extensive discovery proceedings, filing of affidavits and exhibits, and making admissions. The court also had the benefit of the Patent Office file wrapper showing the history of the prosecution of this patent.

The thoroughness of the pre-trial activities of both parties resulted in the elimination of any genuine issue of material fact in dispute. Under such circumstances it has been held that where no factual issues are present and where the patents and products involved are sufficiently simple to make expert testimony unnecessary, disposition under Rule 56 is proper." The court cited authorities, including a patent case, *Steigleder* v. *Eberhard Faber Pencil Co.*, 176 F. (2d) 604 (C. A. 1), certiorari denied, 338 U. S. 893. The opinion in the *Steigleder* case emphasized the advantage of granting summary judgment instead of subjecting the parties to the expense of a trial, where there was no need of expert witnesses to furnish technical explanations bearing on the structure and mode of operation of fountain pens.

In *Vulcan Corporation* v. *International Shoe Machinery Corporation*, 68 F. Supp. 990 (D. C. Mass.), affirmed on opinion of the District Court in 158 F. (2d) 520 (C. A. 1), certiorari denied, 330 U. S. 825, and in *Alex Lee Wallau, Inc.* v. *J. W. Landenburger & Co., Inc.*, 121 F. Supp. 555, 556 (S. D. N. Y.), summary judgments dismissing complaints in patent cases were granted. In the last cited case, the District Judge said: "The Court of Appeals of this Circuit has indicated that the remedy of summary judgment is available in patent suits where no factual issues are raised and where the patents and products involved are sufficiently simple to make expert testimony unnecessary. *Bridgeport Brass Co.* v. *Bostwick Laboratories*, 2 Cir., 181 F. (2d) 315, 316, 319."

United States Circuit Judge Soper said: "The plaintiff makes the additional point that there is no precedent in this court for disposing of a question of patent infringement by summary judgment. The practice, however, is not unknown and is properly adopted where as provided in Federal Rules of Civil Procedure, Rule 56(c), 28 U. S. C. A., there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a

matter of law. [Citing cases.] We find that situation to prevail in the pending case." *Smith* v. *General Foundry Mach. Co.*, 174 F. (2d) 147, 151 (C. A. 4).

Where there was no genuine issue of material fact presented, this court has affirmed a summary judgment for the defendant in a patent case. *Lincoln Electric Co.* v. *Linde Air Products Co.*, 171 F. (2d) 223 (C. A. 6). So, likewise, has the Court of Appeals for the Seventh Circuit. *Davison Chemical Corp.* v. *Joliet Chemical, Inc.*, 179 F. (2d) 793, 795 (C. A. 7). Cf. *Leishman* v. *Radio Condenser Co.*, 167 F. (2d) 890 (C. A. 9).

Long before the adoption of the Civil Procedure Rules, including Rule 56, this court, in an opinion by Judge Mack (a model of brevity in a patent case) held that where the only difference between expert witnesses was not as to any technical meaning or circumstance, but as to the proper interpretation of the patent in the light of the undisputed prior art, the question was for the court and not for the jury. *Hurin v. Electric Vacuum Cleaner Co.*, 298 F. 76, 79 (C. A. 6), decided in 1924.

The attorney for appellant is altogether too strong in his criticism of the trial judge. There is no justification in the context for his statement that "our courts are established to do justice and not merely dispose of cases in a hurried manner." Nor is there justification for his complaint that the court should not have sustained defendant's motion for summary judgment after the case had been set for trial. At the conclusion of the last hearing, the judge had stated that he wanted everything made available for his inspection and persual, so that he would not have to call up the attorneys from time to time; and that, after going through all the material before him, he would feel free to advise the attorneys of his decision, if he became satisfied as to appropriate action on all the questions raised by the motions. The judge did not bind himself to afford the parties a further hearing. He left the matter optional in his own discretion.

In addition to the prior art citations, the District Judge had before him the deposition of the plaintiff-patentee, Bobertz, and his admissions on file made under Rule 56; the depositions of Shurly, sales manager of Plastics Unlimited, and of Wood, its secretary; deposition of Skinner, vice-president of General Motors and general manager of its Oldsmobile Division, and of Chayne, vice-president of General Motors in charge of engineering; affidavits of Barton (identifying a photograph of the 1932 Chevrolet hood), and of Hirshman (identifying photographs of the 1949 Oldsmobile steel hood and the accused plastic hood); and the affidavit of Thorpe identifying the 1949 Oldsmobile steel hood. Moreover, the judge had the benefit of extensive briefs filed by attorneys for the parties. He was in full possession of all essential facts necessary for correct decision of the case.

Judge, Koscinski's logically reasoned and authoratatively supported opinion evinces no haste; but, to the contrary, manifests careful study and calm deliberation. This just jurist, working gamely as he did under the handicap of painful ill health, deserves commendation of the excellent performance of his juristic duty. We concur in the conclusion which he reached concerning the invalidity of the claims of the patent in suit. This being true, it is unnecessary for us to decide or even to discuss the question of infringement. That issue is moot. In *James Heddon's Sons* v. *American Fork & Hoe Co.*, 148 F. (2d) 230, 234 (C. A. 6), Judge Simons thus spoke for this court: "In view of our conclusion that Barnhart's claims are invalid for lack of invention, it becomes unnecessary to consider questions of priority or infringement and the judgment below is affirmed."

In the instant case, the judgment of the United States District Court is likewise affirmed, for the reason that United States Patent No. 1, 911,600, issued May 20, 1933, to Bobertz, et. al., covering a transparent hood for an automobile, is held invalid for lack of invention.

JUL 10 1956
JOHN T. FEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. [redacted]85

GUSTAV H. BOBERTZ, JR.,
Petitioner,
vs.
GENERAL MOTORS CORPORATION,
Respondent

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 938

GUSTAV H. BOBERTZ, JR.,
Petitioner,
vs.
GENERAL MOTORS CORPORATION,
Respondent

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

CHARACTER OF CASE AND OPINIONS OF COURTS BELOW

This is an ordinary patent suit brought by Gustav H. Bobertz, Jr. against General Motors Corporation for infringement of United States Letters Patent No. 1,911,600, issued May 30, 1933, upon application filed November 22, 1932, covering a transparent hood consisting of separate

vertical and horizontal members joined together at their adjoining edges by reinforcing means to form a unitary structure.

The patent expired May 30, 1950, about two weeks after the complaint was served on defendant (May 15, 1950). Since no other suit has been brought for infringement of this patent, this case presents no conflict of decisions between Courts of Appeals. The decision below is based on its own facts and affects no one but the litigants.

Respondent, acting under the provisions of Rule 56 of the Federal Rules of Civil Procedure, moved the District Court for Summary Judgment on the grounds of non-infringement and invalidity of the patent in suit (D. App. 21b).*

The District Court granted respondent's motion on both grounds and dismissed the complaint. The District Court's opinion is reported in 126 Fed. Supp. 780 and is printed in the appendix to the Petition herein beginning at page 1a. The Court of Appeals, Sixth Circuit, affirmed the District Court on the ground that the patent in suit is invalid for lack of invention and did not rule on the issue of infringement. The opinion of the Court of Appeals affirming the District Court is reported at 228 Fed. (2d) 94 and is printed in the appendix to the Petition herein beginning at page 12a.

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*The abbreviation "D. App." is used herein to designate defendant's (respondent herein) appendix.

STATEMENT OF MATERIAL FACTS

The Bobertz patent in suit (D. App. 6b) shows a transparent hood which in form or configuration is substantially a duplicate of the sheet metal hood used on the Chevrolet automobile manufactured and sold by General Motors Corporation in 1932. This was admitted by the patentee Bobertz (D. App. 70b, 75b) and the Court of Appeals so found (228 Fed. (2d) 94 at 99). This is also evident from a comparison of the drawings of the Bobertz patent in suit (copy appended at page 1b) with the 1932 Chevrolet hood (photograph appended at page 2b; also D. App. 52b, 53b). The claims of the patent in suit are limited to a hood made from a plurality of transparent pieces or members connected at their adjoining edges by reinforcing strips in order to form a unitary structure. Both the District Court and the Court of Appeals so found (126 Fed. Supp. 780, 782; 228 Fed. (2d) 94, 97).

In 1949 respondent introduced to the public the Oldsmobile "Rocket" V-8 engine and displayed the "Rocket" engine by means of a plastic hood (photographs of respondent's accused plastic hood appear in defendant's appendix pages 63b-66b and also plaintiff's appendix page 63a). Respondent's hood in form or shape was a duplicate of the metal production hood used on the 1949 Oldsmobiles but was made from a *single sheet* of transparent plastic material the border areas of which were blocked out by opaque paint to provide a central window through which the "Rocket" engine could be observed (D. App. 20b). Photographs of the 1949 Olds steel production hood appear in Defendant's Appendix 56b-62b.

Respondent based its motion for summary judgment on the following incontrovertible, self-proving documents; namely,

(1) A copy of the file wrapper of the patent in suit 1,911,600, authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 3; D. App. 10b-19b; P. App. 114a-124a).

(2) German patent to Rumpler 379,379, issued August 20, 1923 (D. Ex. 4; D. App. 25b) and a translation of the German patent to Rumpler 379,379, August 20, 1923, authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 4-A; D. App. 28b). Rumpler describes and claims an automobile having a hood of transparent celluloid.

(3) LaLocomotion—February 11, 1911, No. 23, page 65 (D. Ex. 5; D. App. 33b, 34b) and a translation of the captions under the photographs in LaLocomotion, February 11, 1911, No. 23, page 65, authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 5-A; D. App. 35b). This publication shows and describes an automobile chassis in which the engine is covered by a glass hood.

(4) The Autocar—September 28, 1912, pages 570 and 571, photostatic copy authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 6; D. App. 39b). This publication shows and describes a Cadillac car with a transparent glass hood.

(5) The Motor—July 2, 1912, pages 965, 966 and 967 (D. Ex. 7; D. App. 42b). This publication shows a Cadillac car with a transparent glass hood.

(6) United States Patent No. 1,045,152, November 26, 1912, "Flying Machine," Earl H. Kelsey (D. Ex. 8; D. App. 46b). This patent shows plastic window for viewing an airplane engine.

(7) The Autocar—May 3, 1913, pages 804 and 805, photostatic copy authenticated under the seal of the Patent Office and certified by the Commissioner of Patents (D. Ex. 5-B; D. App. 36b).

The other proofs consisted of the deposition of petitioner-patentee, Bobertz; admissions on file made by petitioner Bobertz under Rule 36, F. R. C. P.; the uncontroverted affidavit of Barton identifying a photograph of the 1932 Chevrolet hood (D. App. 52b); the uncontroverted affidavit of Hirshman identifying photographs of the 1949 Oldsmobile production steel hood (D. Ex. 2-A) and of the accused plastic hood (D. Ex. 2; D. App. 54b); and the uncontroverted affidavit of Thorpe identifying the 1949 Oldsmobile production steel hood (D. Ex. 2-A; D. App. 67b).

COMPLAINT PROPERLY DISMISSED UNDER RULE 56 F. R. C. P.

Rule 56 of the Federal Rules of Civil Procedure provides that as to any asserted claim summary judgment shall be rendered for the moving party if the pleadings, depositions, and admissions on file show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. The procedure outlined in Rule 56 for terminating groundless litigation has been found particularly appropriate in many patent cases: *Morton Salt Company v. G. S. Suppiger Company*, 314 U. S. 488, 62 S. Ct. 402, 86 Law Ed. 363; *Automatic Radio Manufacturing Company v. Hazeltine Research, Inc.*, 339 U. S. 827, 70 S. Ct. 894, 94 Law Ed. 1312; *Steigleder v. Eberhard Faber Pencil Co.*, 176 Fed. (2d) 604 (C. A. 1); *Milcor Steel Co. v. George A. Fuller Co.*, 122 Fed. (2d) 292 (C. A. 2); *Bridgeport Brass Co. v. Bostwick Laboratories, Inc.*, 181 Fed. (2d) 315 (C. A. 2); *Mas v. Owens-Illinois Glass Company*, 222 Fed. (2d) 889 (C. A. 3), certiorari

denied 350 U. S. 1016; *Smith v. General Foundry Machine Company, Inc.*, 174 Fed. (2d) 147 (C. A. 4); *Lincoln Electric Co. v. Linde Air Products Co.*, 171 Fed. (2d) 223 (C. A. 6); *Davison Chemical Corp. v. Joliet Chemicals, Inc.*, 179 Fed. (2d) 793 (C. A. 7); *Young v. Ralston-Purina Co.*, 88 Fed. (2d) 97 (C. A. 8); *Park-in-Theatres, Inc. v. Perkins*, 190 Fed. (2d) 137 (C. A. 9).

All of the evidence relied upon by the respondent in support of its motion is in the form of self-proving documents which have not been, and could not be, contradicted in any manner by the petitioner. The structures of the plural piece transparent hood claimed in the patent in suit, of respondent's single piece plastic transparent hood, and of the transparent hoods shown and described in the prior art are simple and such that they may be readily comprehended by the Court and without the need of any technical explanation by an expert witness, and both the District Court and the Court of Appeals so held (126 Fed. Supp. 780, 781; 228 Fed. (2d) 94, 100).

The prior art German patent to Rumpler 379,379 (D. App. 25b-27b) and an English translation thereof (D. App. 28b-32b) describes an automobile hood of transparent material so that the engine can be viewed. Rumpler's claim 4 is directed to an

> "Automobile * * * characterized by a motor hood of transparent celluloid" (D. App. 32b).

The French publication "LaLocomotion" (D. App. 33b-35b) shows a glass hood for demonstrating the engine of a Bayard-Clement automobile. A photograph of "LaLocomotion" is appended at page 3b. The fact that "LaLocomotion" hood is of glass is of no materiality because the claims in suit are not limited to a plastic hood. Further, Rumpler taught the use of a plastic hood. There is addi-

tional prior art of record cited by the District Court and the Court of Appeals showing that long before the Bobertz patent in suit it was commonplace to make an automobile hood of transparent material so that the engine could be viewed, 228 Fed. (2d) 94, 97; 126 Fed. Supp. 780, 784.

The claims of a patent should be interpreted not only in the light of the specification but also in the light of its file history, *Schriber-Schroth Company v. Cleveland Trust Company*, 311 U. S. 211, 217-218, 61 S. Ct. 235, 85 Law Ed. 132, 135-136. The file history clearly shows that the patent in suit is limited to a *multiple piece* transparent hood and does not cover respondent's one piece hood. Referring to the file history, the Court of Appeals stated, 228 Fed. (2d) 94 at 97:

> "The inventors, while pursuing the application in the Patent Office, cancelled claims sufficiently broad in scope to cover a one-piece hood made of a *single sheet* of transparent plastic and adopted claims specific as to a *multiple-piece* hood with reinforcing ribs connecting the individual members." (Italics ours.)

The District Court likewise so found, 126 Fed. Supp. 780 at 783.

The principal issue in this law suit is indeed simple; namely, *did it amount to patentable invention in 1932 to duplicate in transparent material the then current Chevrolet production automobile hood?* Both Courts below answered this question in the negative.

Although respondent's accused hood (D. Ex. 2) was placed in evidence, this hood was not at all necessary to the decision of the Court of Appeals affirming the District Court on the ground that the Bobertz patent in suit was invalid. This only required an understanding of the hood shown in the patent in suit (admittedly a reproduction of

the 1932 Chevrolet hood in plastic instead of steel D. App. 70b, 75b) and of the transparent hoods shown in the prior art, such as the German patent to Rumpler 379,379 and the French publication "LaLocomotion" February 11, 1911 in the light of the high standard of invention set by this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 95 Law Ed. 162. A comparison of the patent in suit with the prior art on the issue of validity will demonstrate the simplicity of the hood structure in issue and that this Court can understand this structure without the need for any technical explanation by an expert witness.

It is clear that there is no genuine issue as to any material fact bearing on the question of validity; that the question of validity was properly determined as a matter of law, *United States v. Esnault-Pelterie*, 303 U. S. 26, 30, 58 S. Ct. 412, 414, 82 Law Ed. 625; and that the case was properly disposed of by way of summary judgment of dismissal, *Morton Salt Company v. G. S. Suppiger Company*, and other cases cited, *supra*, pages 5-6.

PETITIONER HAD AMPLE TIME, AND IN FACT FULLY PRESENTED HIS CASE AGAINST RESPONDENT'S MOTION FOR SUMMARY JUDGMENT

Respondent's motion for summary judgment was served on petitioner April 1, 1954 and the hearing on this motion before the District Court was had on May 24, 1954. Petitioner had ample time to prepare his opposition to this motion. On April 10, 1954 petitioner filed an eighteen (18) page brief opposing respondent's motion, on May 5, 1954 petitioner filed a fourteen (14) page brief analyzing the prior art, and on May 6, 1954 presented Exhibits D, E, F and G which are present in plaintiff's appendix (P. App. 61a, 62a, 63a, 64a).

Petitioner also argued in opposition to respondent's motion before the District Court on May 24, 1954 (D. App. 88b). At this hearing petitioner's counsel again referred to his detailed briefs filed in opposition to the motion (D. App. 88b). Petitioner's brief included the subject of file wrapper estoppel (D. App. 88b). At the close of the argument the District Court set a date of July 12, 1954 for resuming the hearing *if necessary* but very clearly pointed out that a further hearing might not be necessary and that he might decide respondent's motion in the interim. The District Court said:

> "* * * I probably will want to ask counsel some questions and perhaps ask for some discussion. *But if I feel, after going through all of the material that is before me that I can satisfy all of the questions raised here today on all three motions, why, I will feel free to let you know what my decision is*" (D. App. 89b). (Italics ours.)

Later on in the proceedings the District Court again said:

> "The Court: Well, I'll say this: I hope to be able to resume the hearing, *if a hearing will be necessary, or decide the motions by that time;* * * *" (D. App. 89b). (Italics ours.)

In the light of this record and the admonition of the District Court, it is clear that petitioner had ample time to, and in fact did, fully present his case in opposition to respondent's motion for summary judgment.

CONCLUSION

Since this case has no importance beyond the immediate facts and parties involved therein and was decided by the proper application of well established principles of law to a specific set of facts, the petition presents no reason whatsoever for review on writ of certiorari and should be denied.

Respectfully submitted,

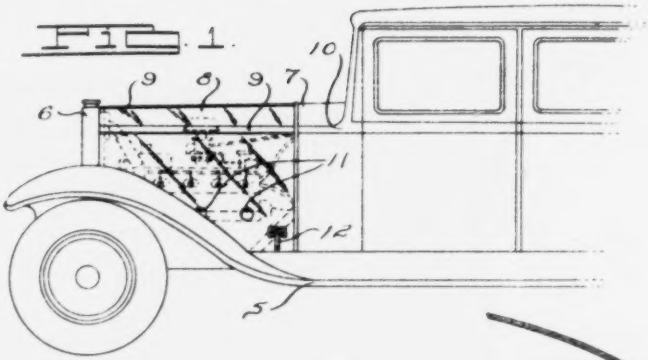
GEORGE L. DeMOTT,
ARTHUR RAISCH,
Counsel for Respondent.

May 30, 1933. G. H. BOBERTZ, JR., ET AL 1,911,600

AUTOMOBILE HOOD

Filed Nov. 22, 1932

Fig. 1.



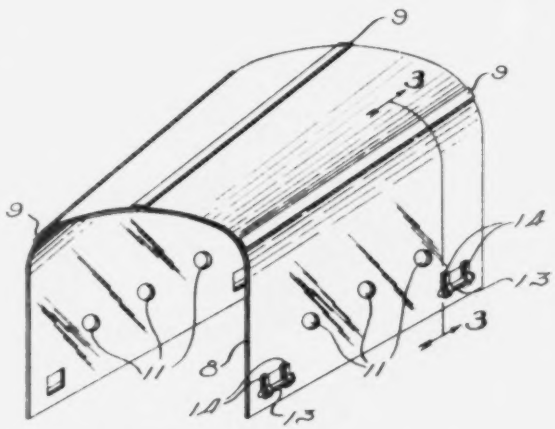


Fig. 2.

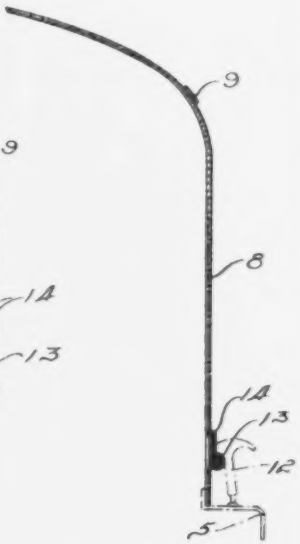


Fig. 3.

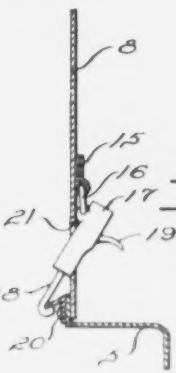
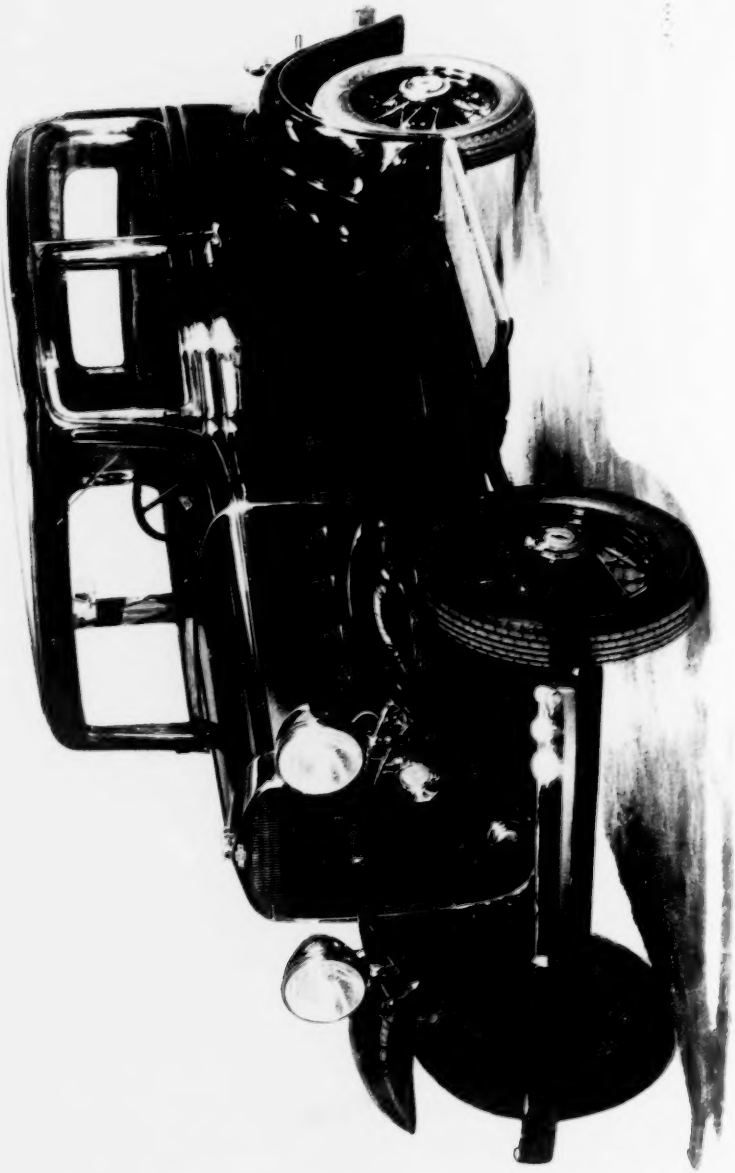
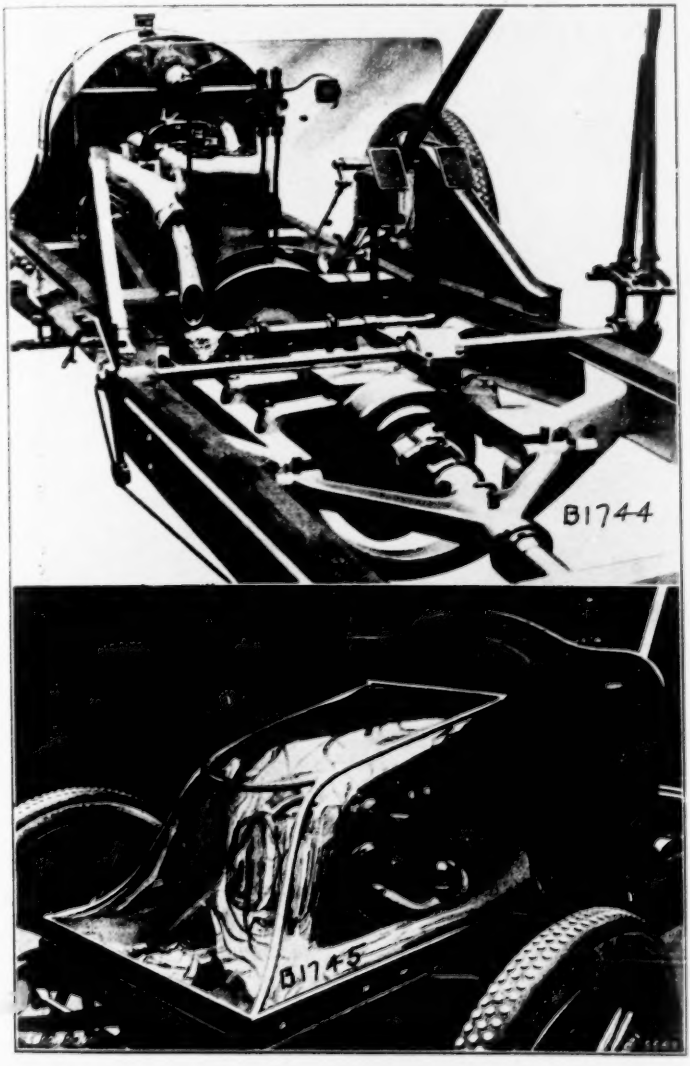


Fig. 4.

INVENTORS.
Timothy J. La Fontaine,
Gustav H. Bobertz, Jr.
BY Clifton M. Smith
ATTORNEY





PRÉSENTATION ORIGINALE D'UN MÉCANISME. — *En haut*, châssis Grégoire muni d'un garde-crotte en verre. — *En bas*, châssis Bayard-Clément avec capot en verre.

Bayard-Clement chassis with glass hood